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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,766	12/18/2001	Adrian Crisan	1662-55100 JMH (P01-3806)	4713

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EXAMINER	
ROMANO, JOHN J	
ART UNIT	**PAPER NUMBER**
2192	

MAIL DATE	DELIVERY MODE
11/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/029,766	**Applicant(s)** CRISAN ET AL.	
	Examiner John J. Romano	**Art Unit** 2192	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED August 14th, 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, ~~the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered~~ and an explanation of how the ~~new or amended~~ claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1,4-9,11-16,18-20,27 and 28*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

1. Continuation of 11:

Applicant's arguments have been fully considered but they are not persuasive. For example,

(A) It should first be noted, that the examiner interprets claim 1, to include various steps, which are carried out during system initialization. The system initialization is interpreted as the system environment before the operating system is loaded, typically the boot process, which may further provide a pre-boot execution environment. The system initialization is interpreted as concluding with the loading of an operating system. Accordingly, claimed limitations are interpreted to take place during the system initialization process; however not necessarily requiring each and every step to take place during a single initialization process. Correspondingly, applicant's claimed steps, which take place during the system initialization do not preclude the interpretation that multiple system initializations, rebooting, etc. may be carried out as part of the prescribed method.

It appears to the examiner that the main issue that applicant is attempting to convey is that the claimed various steps, of claim 1, are required to take place during a single initialization phase, wherein each initialization performs all of the claimed steps. However, as presently claimed the examiner does not interpret the language of claim 1, to preclude multiple system initialization attempts (i.e., rebooting, etc.). Contrary to Applicant's assertion that rebooting precludes applicability (Remarks (8/14/2007) at p. 8,) the plain language of the claim is not interpreted to require or equate to *having previously never loaded an operating system* or similarly "rebooted". The examiner submits that if applicant's logic was upheld, then the claims

could reasonably be limited to systems that have never previously loaded an operating system or that reboot.

(B) It should also be pointed out, that applicant does not make the express argument that *Marsh* does not teach flashing a ROM *during initialization.* Rather applicant argues that "*Marsh* does not show or suggest the concept of flashing the ROM with an upgraded image before the loading of any portion of the operating system in RAM" (Remarks (8/14/2007) at p. 8.)

In that regard, *Marsh* was not applied to teach the explicit language of the instant limitation ("before the loading of any portion of the operating system in RAM"). Rather, Doherty was applied as presented in the previous office action (office action (6/15/2007) at pp. 9-10,) and reproduced below:

> However Doherty discloses:
> "...before loading any portion of the operating system in a random access memory associated with the CPU..." (E.g., see Fig. 2 & Column 1, lines 23-36), wherein at boot up before loading an operating system into main memory, a client may request instructions which install an operating system. Additionally, it should be noted that Doherty also discloses that the BIOS 220 is distinct from an operating system that client may boot to during boot-up (see Column 4, lines 4-7).

Doherty, and the combined teaching of Marsh, Asco and Jennery, are analogous art because they are both concerned with the same field of endeavor, namely, an automated method to update software. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Marsh's teaching of updating software by flashing the ROM upon startup (see Marsh above), with Doherty's teaching of receiving the instructions to do so during start up as well. The motivation to do so would have been to further achieve Marsh's objective of "...avoiding

manual intervention..." (Page 2, Paragraph [0013]), and Asco's objective as disclosed above.

It should also be metioned that applicant attacks *Marsh* singularly with respect to a claimed limitation rejected with a combination of references; in particular *Marsh* is not applied against the express and explicit language of "before any portion of the operating system". *Marsh* is applied to flashing a ROM, wherein the upgraded image is already obtained (Final Rejection (6/15/2007) at p. 7.) In this respect, the fact that *Marsh* does not explicitly teach downloading the upgraded image during initialization (one specific step) certainly does not mean *Marsh* cannot disclose flashing the ROM with an upgraded image during initialization (a separate and distinct step). Truly, "flashing the ROM" with an upgraded image, is not necessarily dependent upon how the image was obtained.

Therefore, *Marsh* does indeed teach flashing the ROM with an upgraded system during system initialization and certainly is applicable to combination with *Doherty* as applied previously and above.

(C) Subsequently, applicant asserts that *Marsh* "suggests multiple system initialization attempts and therefore precludes applicability of Marsh towards the claimed subject matter" (Remarks (8/14/2007) at p. 8,) seemingly based on the position that the language of the claims require the various steps which take place during a single initialization; and thus, limited to preclude rebooting or alternatively, to require a single (i.e., each) initialization or a single boot process to perform each of the various steps (Remarks (8/14/2007) at p. 7,) the examiner again respectfully disagrees. As addressed above, the examiner's position is that the claim language does not preclude the interpretation that multiple system initializations attempts, rebooting, etc.

and thus may be carried out as part of the prescribed method. Even arguably, the fact that *Marsh* downloads the upgraded software with the operating system does not mean that applicability of *Marsh* is precluded from teaching the separate and distinct concept of flashing the ROM with an upgraded image during initialization.

(D) Next, applicant similarly submits "that the claim language equates to having never loaded an operating system during a system initialization until the upgraded image is received and flashed in ROM" (Remarks (8/14/2007) at p. 8 – emphasis in original.) It is unclear to the examiner if applicant is intending to imply that the steps are required to be performed in a "single" initialization as addressed above in steps (A)-(C) or if applicant intention is to imply that the invention implements a novel loading process of the operating system that is after initialization. In either case, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

(E) In response to applicant's argument that "Doherty fails to disclose that an upgraded image is received and flashed to ROM" (Remarks (8/14/2007) at p. 9,) the examiner respectfully points out that Doherty is not applied to teach flashing the ROM. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(F) Similarly, independent claims 9, 16 and 27 are rejected and the examiner's position is maintained with respect to the verbatim arguments (Remarks (8/14/2007) at pp. 10-19,) as addressed above in sections (A) and (B). Correspondingly, the dependent claims to independent claims 1, 9, 16 and 27 are rejected at least for the reasons disclosed hereinabove.

It is also noted that applicant's arguments regarding the rejections under 35 U.S.C. § 103 are similar and in some cases repeated as presented in the previous response (Remarks (4/03/2007) at pp. 6-12,) and have already been addressed on the record. (Final Rejection (6/15/2007) at pp. 3-5.) The rejections are maintained.

For at least the reasons set forth above, applicant's response does not place the application in condition for allowance. Prosecution remains closed.

ERIC B. KISS